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IN THE

Supreme Court of the United States

OCTOBER TERM, 1952

No. 46

HUGH W. SANFORD, PETITIONER

vs.

ROBERT C. KEPNER

BRIEF FOR PETITIONER

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Supreme Court of the United States

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BRIEF FOR PETITIONER

The petition was filed herein for review of a decision of the United States Court of Appeals for the Third Circuit.

The Opinions of the Courts Below

The opinion of the District Court appears at R.6, and is reported in 99 F. Supp. 221, 90 USPQ 188. The opinion of the Court of Appeals for the Third Circuit appears at R.16 and is reported in 195 F.2d 387, 93 USPQ 57.

Jurisdiction

The Statutory provision believed to sustain the jurisdiction of this Court is Title 28, US. Code, Section 1254.

Jurisdiction is also indicated by Rule 38, 5 (b) of this Court, there being a conflict of opinion between several Circuit Courts of Appeal on the question involved herein.

The order allowing certiorari was granted June 9, 1952, (R.23).

Concise Statement of the Case

This action was instituted by the Petitioner in the United States District Court for the Middle District of Pennsylvania to obtain a judgment authorizing the Commissioner of Patents to issue a patent to the Petitioner.

In his amended complaint (R.1), Petitioner alleged

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† Appendix, p. 19.

jurisprudence under Sec. 4915 R.S. (35 U.S. Code, Sec. 63).[1]

The Petitioner has filed an application for Letters Patent for an invention for which the Respondent also had made an application for Letters Patent. While these two applications were pending, an interference proceeding was instituted by the Patent Office to determine the issue of priority of invention between the parties. As a result thereof, priority was awarded to the Respondent, Robert C. Kepner.

The Petitioner's application then was rejected by the Commissioner of Patents, by order of the Board of Interference Examiners, because of the alleged priority of invention of the Respondent. The Petitioner filed his complaint in the District Court for review of the finding of priority, and also to determine the issue of patentability of the subject matter defined in the counts of said interference proceeding (R.2-3). The amended complaint (R.1) set forth that the Respondent was not entitled to an award of priority because the counts were unpatentable to the Respondent in view of certain prior patents issued to the Petitioner and to others, as set forth in the amended complaint (R. 4-5).

The District Court held that Petitioner had failed to sustain the heavy burden imposed by rule of this Court in *Morgan v. Daniels*, 153 U.S. 120, 125, of establishing "that the decision of the Board of Interference Examiners is incorrect." (R. 15). Therefore, the Court found for the Respondent on the issue of priority.

The District Court entered a further finding that the issue of patentability need not be considered

> "In other words, the Court took its position with the line of cases that holds that in a 4915 action patentability need not be considered where he claimed priority is not established." (R.7).

On appeal, this judgment was affirmed by the Court of Appeals for the Third Circuit. (R. 18-21).

Thereafter this petition was filed for the consideration of the following question:

Should the District Court have decided the issue of patentability, in a suit under Sec. 4915, R.S., of the counts

[1] Appendix, p. 16

of the interference, first and foremost, even though the issue of priority be decided in this suit, against the plaintiff?

Assignment of Errors

It is submitted that the Court of Appeals erred:

1. In refusing to hold that the District Court should consider, first and foremost, the issue of invention of the counts of an interference proceeding, in a bill in equity under Section 4915, R.S.

2. In holding that Section 4915, R.S., does not require a District Court to incorporate in a judgment dismissing an applicant's claim of priority of invention an adjudication of the patentability of that invention.

3. In holding that a District Court, in a bill in equity filed under Section 4915, R.S., involving the question of priority of invention, should not pass upon the issue of patentability of the patent claims which were the subject matter of the interference proceeding in the Patent Office.

Summary of Argument

The decision of the Court of Appeals below is contrary to the language of the Statute, Section 4915, R.S., as revealed by the clear import of its terms, and from its legislative background.

The Statute clearly states that where an applicant for a patent is dissatisfied with the decision of the appropriate Board in the Patent Office, he may have remedy by a bill in equity, and the Court may adjudge that the applicant is entitled to receive a patent "as the facts in the case may appear." This rewording of the language in Section 16 of the Patent Act of 1836[2] "as the fact of priority of right or invention shall in any such case be made to appear" is intended to have the same meaning and certainly not a more restricted meaning, limited only to priority and not patentability, as the Court below has held.

The decision of the Court of Appeals below misapplies the decisions of this Court in *Hill v. Wooster*, 132 U.S. 693, 698, and in *Hoover Co. v. Coe*, 325 U.S. 79, in which this Court has plainly stated that the question of patenta-

[2] Appendix, p. 20.

bility of the involved counts of the interference should be determined by the District Court in a suit under Section 4915, R.S.

Other Courts of Appeal have followed the decisions of this Court consistently, as in *Triplett et al v. Line Material Co.*, 133 F.2d 533, 56 USPQ 398; *Minneapolis Honeywell Regulator Co. v. Milwaukee Gas Specialty Co.*, (C.A. 7), 174 F.2d 203; and *Knutson v. Gallsworthy* (Dist. of Col.), 164 F.2d 497, 74 USPQ 324.

Argument

The decision of the Court of Appeals below is contrary to the language of the Statute, Section 4915, R. S., as revealed by the clear import of its terms and from its legislative background.

This Court has reviewed the history of Section 4915, R.S., at considerable length in *Hoover Co. v. Coe*, 325 U.S. 79, 90. As therein pointed out, the origin of this Statute was contained in the Patent Act of 1836, Section 16[2], which provided that "whenever a patent on application shall have been refused on an adverse decision of a board of examiners" the applicant "may have remedy by bill in equity", and the Court may adjudge that the applicant receive a patent for his invention, "as the fact of **priority of right or invention** shall in any such case be made to appear."

Section 16 of the Act of 1836 had provided for a remedy by bill in equity both in the case of interfering patents already issued or granted and the case of interfering applications or rejection of pending applications.

The then existing patent laws were combined in the Consolidation Patent Act of July 8, 1870, wherein these provisions were separated, and Section 52 thereof[3] was made to apply to rejected applications, while Section 58 provided for suit in the case of interfering issued patents. Actions relating to interfering patents are now covered by Section 4918, R.S. (35 U.S. Code, Sec. 66), not here involved.

The Consolidation Act of 1870 was referred to by this Court in *Butterworth v. Hoe*, 112 U.S. 50, 66:

[2] Appendix, p. 17
[3] Appendix, p. 21

"The Act of July 8, 1870, 16 Stat 198, revised, consolidated and amended the statutes then in force on the subject, and the substance of its provisions, material to the present inquiry, have been carried into the existing revision."

The provisions of the Act of 1870 were incorporated in the Revised Statutes of 1873. These provisions, however, respecting a bill in equity for review of a rejection of a patent application, contain the same language in this portion thereof dealing with the adjudication of the right of the applicant, whether he is entitled to receive a patent for his invention "as the facts in the case may appear". This is a mere modification of the language, a consolidation of the terms in the earlier Patent Act of 1836, which made it quite clear in so many words that the Court of Equity should adjudge that "the fact of **priority of right or invention** shall in any such case be made to appear."

The earlier provision in the Act of 1836, therefore, spelled out in so many words that both priority and invention should be determined in the equity suit. This provision could not have been misunderstood, as there expressed.

It must be apparent from a consideration of the Statutes of 1836 and 1870 that there was no intention on the part of Congress to change the provisions with respect to the adjudication in such equity suit of priority or invention. On the contrary the language used in the Act of 1870, and which was later carried over into the Revised Statutes, shows that the change of language was merely an omission of surplusage, a consolidation, the substitution of words which were clearly intended to mean the same thing.

The earlier Statute of 1836 had specified that the issue in such bill in equity was the fact of priority or invention. The change of "'fact" to "facts" in the Statute of 1870 and the Revised Statutes, Sec. 4915, show that Congress intended both the fact of priority and the fact of invention, to be a proper issue in such suit.

This conclusion is confirmed by the first draft of the

Consolidation Patent Act of 1870, as first passed by the House of Representatives, according to Volume 95, The Congressional Globe, for June 24, 1870, page 4820. This provision of the statute, as contained in the House Bill, constituted Section 48.[4]

This Section 48 had specified that the subject matter of the equity suit should be restricted to matter in the decision of the Commissioner but that the suit should determine what is the invention. The substituted provision according to Section 52 of the Act of 1870 is obviously a change in language of original Section 48 without any evident change of intention. On the contrary it would appear that the language used in Section 52 of the Act of 1870 is the same language that appears in Section 4915, R.S., providing that the Court should adjudge that the applicant is entitled to receive a patent "as the facts in the case may appear", which imposed a duty on the Court to determine invention as well as priority with respect to the applicant's claims.

Thus we see that all through these several statutes there is an indicated intention on the part of Congress that a suit in equity to obtain a patent should determine both priority and invention. It was not to be restricted merely to the matter which appeared in the decision of the Commissioner but that full investigation of the facts and invention is evidenced by the language of the Act of 1836, and the original draft of this Bill which was merely rewritten by the Senate in the form in which it appeared in the Act of 1870.

Consequently, an applicant seeking relief under Section 4915, R.S has a right to a determination, when requested, of **priority or invention**. Either was a proper issue in the suit. The Court should determine either or both questions, if put in issue by the parties, determining whether the party is entitled according to law to his patent "as the facts in the case may appear", not only the issue of priority but also the issue of patentability.

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[4] Appendix, p. 21

This is the interpretation which this Court has applied to the language of the Statute in *Hill v. Wooster*, 132 U.S. 693, 698, and in *Hoover Co. v. Coe*, 325 U.S. 79.

The decision of the Court of Appeals below has misapplied the decisions of this Court.

The opinion of the Court of Appeals below characterized the language of this Court in *Hoover Co. v. Coe*, 325 U.S. 79, as engendering "a certain measure of ambiguity" (R.19) in the applicable decisions on this question, and misapplied entirely the language of the Court in *Hill v. Wooster* stating that nothing therein required

> "a district court to incorporate in a judgment dismissing applicant's claim of priority of invention an adjudication as to the defendant's entitlement to letters patent". (R.20-21).

In *Hill v. Wooster*, the bill in equity was filed to review a holding by the Board in the Patent Office that the plaintiff was not entitled to the grant of a patent because he had not established priority of invention over the defendant. The case was decided on priority alone. This Court noted that neither party raised the issue of patentability. Both parties were perfectly willing to have the matter decided solely on priority without any adjudication of the question of patentability. This was not sufficient, however, in the view of this Court:

> "It necessarily follows that no adjudication can be made in favor of the applicant, unless the alleged invention for which a patent is sought is a patentable invention. The litigation between the parties on this bill cannot be concluded by solely determining an issue as to which of them in fact first made a cabinet creamery. A determination of that issue alone, in favor of the applicant, carrying with it, as it does, authority to the Commissioner to issue a patent to him for the claims in interference, would necessarily give the

> sanction of the court to the patentability of the invention involved. * * * But neither the Circuit Court nor this court can overlook the question of patentability." (698 of 132 U.S.)

This Court did not find it necessary even to consider the issue of priority, and thus relegated that issue to secondary importance. Contrary to the expressed view of the Court of Appeals below, this Court clearly indicated therein that the issue of patentability should have first consideration and the District Court should decide the question of invention or patentability as well as priority, when put in issue.

The Court of Appeals below interpreted this language of the Court in *Hill v. Wooster* as suggesting

> "at most a privilege, certainly not a duty, of the district court to pass upon patentability at the instance of an unsuccessful claimant of priority." (R. 21)

Such an interpretation of the language of this Court appears to be unjustified where the Court in *Hill v. Wooster* failed to base its decision on priority, but decided the case solely on patentability.

There would have been more reason for the interpretation of the Court of Appeals if the decision in *Hill v. Wooster* were based on priority as the first consideration, and then, if that issue be decided in favor of the plaintiff, had gone ahead and decided the issue of patentability as of secondary importance. However, this Court did not even consider the issue of priority, but clearly indicated by the manner in which the matter was decided that patentability was the first, and foremost, consideration.

This court has many times indicated that the question of patentability is of public importance, and when the issue of patentability or validity is raised in a case, it should be decided by the court in the public interest, as noted, for instance, in *Sinclair & Carroll Co. Inc., v. Interchemical Corp.*, 325 U.S. 327, 330.

"It has come to be recognized, however, that of the two questions, validity has the greater public importance."

If there were any doubt about the decision in *Hill v. Wooster*, this was clarified by the statement in the opinion of Justice Roberts in *Hoover Co. v Coe*, 325 U.S. 79, in the footnote attached thereto:

"29. Section 16 of the Act of 1836, 5 Stat. 123, *supra*, expressly provided that upon a bill filed as a result of Patent Office decision on an interference the court might adjudge either of the patents void in whole or in part. This language was evidently omitted in later acts as surplusage, for obviously if either patent was void for lack of invention or other cause, the question of interference disappeared." (p. 90 of 325 U.S.).

Justice Roberts was a judge of great learning in the field of patent law. His opinions show a profound understanding of this branch of the law. In that case he had made a thorough study not only of this particular section, but also of its relation to prior laws and to its legislative history, as revealed in the opinion itself.

Certainly such a carefully prepared opinion does not justify, it is submitted, the expressed suggestion in the decision of the Court of Appeals below that it engendered "a certain measure of ambiguity" in this question. On the contrary, if there were any previous misunderstanding, that statement by Justice Roberts should have removed all possible doubt, and left it perfectly clear that the Court should decide invention or patentability, as well as priority, when put in issue.

Justice Roberts stated therein that the change in language from Section 16 of the Patent Act of 1836 to Section 52 of the Act of 1870, and the similar provision of Section 4915, R.S., was merely an omission of surplusage, a consolidation of language without change of intent. The clear expression in the

Act of 1836 that the Court should decide the bill in equity "as the fact of **priority of right or invention** shall in such case be made to appear" was merely shortened to the words "as the facts in the case may appear". In all other respects this portion of the statute was the same.

Had the Congress intended to restrict the provision to a decision on priority alone, it would have been a simple matter to have said in the Act of 1870 "as the fact of priority of right shall in any such case be made to appear". On the contrary, the Congress did not so frame this portion of the law in consolidating the provisions in the Act of 1870. The Congress changed this language to "the facts", whatever they may be with respect to the issues raised in the suit, whether priority or invention. Such issue, properly raised in the suit, that is relevant to the determination of the right to patentability, should be decided by the District Court. Both invention and priority are germane to that question.

That is the interpretation which has been placed on this section of the statute by the Court of Appeals for the District of Columbia, having regard to the decisions of this Court both in *Hill v. Wooster* and in *Hoover Co. v. Coe*, supra.

In *Knutson v. Gallsworthy*, 164 F. 2d 497, the decision, written by Justice Prettyman, reviewed at considerable length the authorities on this question and held that the issue of patentability must be decided. There, as in this case, the District Court had confirmed the decision of the Patent Office on priority so that the plaintiffs had not prevailed on the issue, and did not prevail in the Court of Appeals. Nevertheless, the Court of Appeals did not find it necessary to decide the issue of priority, but rested its decision solely on the issue of patentability. The Court stated in part as follows:

"We have reexamined the cases cited by the Court to the foregoing, but in none of them does it appear that the trial court declined to pass upon an

issue raised in the pleadings before it. (p. 500 of 164 F. 2d).

* * * * * * *

"We note also that the (Supreme) Court referred with apparent approval to the decision of this Court in *Radtke Patents Corp. v. Coe*, in which we held that if an issue as to patentability is raised in the District Court in an action under R.S. §4915, it must be decided. In the case at bar, the issue of patentability was raised in the District Court and is raised here, and so must be decided. * * * (p. 500 of 164 F.2d).

"*We go only so far as to say that patentability is a proper issue in a proceeding under Section 4915 and, if raised, must be decided, even though the Patent Office decision from which the case arose was in an interference proceeding.*" (p. 501 of 164 F. 2d. Italics ours.)

The Court of Appeals below conceded a diversity of opinion on this issue not only with respect to the District of Columbia Court of Appeals, but also with respect to the Court of Appeals in the Seventh Circuit, according to the decisions in *Triplett v. Line Material Co.* (C.C.A. 7), 133 F. 2d 533, 56 USPQ 398, and *Minneapolis Honeywell Regulator Co. v. Milwaukee Gas Specialty Co.* (C.A. 7), 174 F. 2d 203.

In the Triplett case the opinion of Judge Lindley, joined in by Justice Minton when sitting on that court, stated:

"Defendant contends, and the District Court held, that it was the province of the court, under *Hill v. Wooster*, 132 U.S. 693, *to determine first of all whether the applications disclose patentable inventions.* This, we think, is correct. (p. 534 of 133 F. 2d.)

* * * * * * *

"In view of the facts mentioned and further evidence in the record which we do not deem it essential

to refer to, the District Court properly held the claims embraced in the two applications not patentable. *In view of our conclusions, it is unnecessary to discuss the issue of priority* or that of invalidating sales.

"The judgment is affirmed." (Italics ours). (p. 536 of 133 F. 2d.)

This was reiterated in the Minneapolis case, affirming the decision of the District Court, per curiam:

"He concluded as a matter of law that in an action to obtain a patent, the court must determine first of all whether the applications disclose patentable invention, and that the claims should be read in the light of the specifications and construed in the light of all the facts."

Refusing to follow those earlier decisions in other circuits, as well as the decisions in this Court, as mentioned above, the Court of Appeals below, as did the District Court (R. 7), referred to decisions in the Sixth Circuit (R. 19) in *Heston v. Kuhlke*, 179 F. 2d 222, and *Cleveland Trust Co. v. Berry*, 99 F. 2d 517. The earlier of those cases in the Sixth Circuit was decided before the clarifying language of this Court in *Hoover Co. v. Coe*, if it needed clarification, and the latter case merely reiterated the same holding without reexamining the issue in the light of Justice Roberts' opinion. Consequently, those decisions no longer should be followed, and both the District Court and the Court of Appeals below fell into clear, reversible error in following such authorities, rather than the decisions of this Court in *Hill v. Wooster* and *Hoover Co. v. Coe*, and the decision of the Court of Appeals for the District of Columbia in *Knutson v. Gallsworthy* which was based on that same authority.

This Court had a proper concept of the matter involved in deciding that the District Court should consider both priority and patentability in a bill in equity under Section 4915, R.S., because priority is necessarily involved

with the issue of patentability and requires a determination of the position of the invention in the art to which it appertains.

The court cannot decide priority in a vacuum.

It is essential that the Court take into consideration the art in which the invention is made, and determine the place in the art which the invention occupies in order properly to evaluate the scope or protection of the counts or the claims of the interference proceeding. The interpretation of the claims is essential to the determination of priority, and is a proper issue in a bill in equity under Section 4915, R.S. *General Electric Co. v. Steinberger*, 208 Fed. 699, 717; affirmed (C.C.A. 2), 214 Fed. 781, 786.

Doubtless the framers of the patent law had this concept clearly in mind, that it is necessary to determine the place in the art that the invention occupies in order to decide whether the applicant seeking a patent is entitled to one. The Congress provided in the Act of 1836 for a decision on a bill in equity of priority or invention, as shall be made to appear. These are the controlling facts, priority and invention. They are the facts as in the case may appear according to the Act of 1870 and the Revised Statutes, Section 4915. The latter is not restricted to the determination of the single fact of priority, but to determination of "the facts", priority and invention, as "in the case may appear".

The Respondent has sought to mislead the Courts below by urging that this is an attempt to void the patent issued to him. The petitioner has not urged that the Court has jurisdiction to pass on the validity of the patent as a whole. However, the counts of the interference may be considered both as to priority and as to invention. The fact that these counts also appear as claims in the Respondent's patent does not affect the duty of the Court to determine invention as well as the priority of the interference counts.

This was clearly stated by the Court in *Butterworth v. Hoe*, 112 U.S. 50, 63:

"Thus every case is fully provided for, both when the Commissioner wrongfully refuses to issue a patent, and when, in cases of interference, he erroneously issues one; * * * ".

The Importance of the Question Presented.

The decision below would prohibit the District Court from receiving evidence on the question of patentability of the invention involved in an interference proceeding. The Court would be left with the alternative either of refusing to decide the question of invention, or if decision be made, it is likely to be a nullity because the Court would not have all the evidence that would bear on the question of invention.

In this instance, the patentability of the interference counts may depend upon the relation of the subject matter thereof with respect to Petitioner's prior patent, as set forth in the amended complaint (R. 4-5), taken alone or with other patents listed. This relation is also important to the question of priority and should have been considered at the same time by the District Court so that the Court would have had the relation of these respective applications and patents to have determined whether the Respondent has made any patentable invention over the alleged prior invention of the Petitioner, as disclosed in his earlier patent. Therefore, the patentability of the involved counts to the Respondent is in fact material to the question of priority.

Had the Court considered the question of invention first as it should be, it is very likely that an entirely different view would have been had as to the question of priority, because the District Court then would have been able to evaluate the smallest of contributions made by the Respondent, if any, over Petitioner's prior patent, taken alone or with other patents set forth in the amended complaint.

Consequently, it is not just a matter of reviewing the prior art and determining whether the claims here

involved may be patentable over this, but it has a very real bearing on the question of priority which the District Court decided without the benefit of the relation of the present invention to Petitioner's prior patent.

Where the District Court does take into consideration the prior art and the relation of the counts of the interference to that prior art, a very different result may be obtained as to the question of priority in the interference. Consequently, the matter here urged is of great importance, because it tends to result in a more nearly correct decision on priority, as well as protecting the public interest in adjudicating the question of invention as well as priority in the one suit.

Conclusion

Both the language of the Statute and the decisions of this and other courts having proper cognizance of the question have held unequivocally that the District Court should decide both priority and patentability when raised in a bill in equity, filed under Section 4915, R.S.

Therefore, it is submitted that the decision of the Court below should be reversed, with directions to review fully the questions raised by the amended complaint.

Respectfully submitted

J. Preston Swecker,
Attorney for Petitioner

Washington, D.C.
September 29, 1952

APPENDIX

Statutes Involved

Revised Statutes of 1874, Section 4915 (35 U.S. Code, Section 63):

"Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal or decision; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally

taken and produced in the suit. R.S. Section 4915; February 9, 1893, c. 74, Section 9, 27 Stat. 436; March 2, 1927, c. 273: Section 11, 44 Stat. 1336; March 2, 1929, c. 488, Section 2(b), 45 Stat. 1476; August 5, 1939, c. 451, Section 4, 53 Stat. 1212."

[2] Patent Act of 1836 (Act of July 4, 1836, ch. 357, 5 Stat. 117):

"Section 16. And be it further enacted, That whenever there shall be two interfering patents, or whenever a patent on application shall have been refused on adverse decision of a board of examiners, on the ground that the patent applied for would interfere with an unexpired patent previously granted, any person interested in any such patent, either by assignment or otherwise, in the one case, and any such applicant in the other case, may have remedy by bill in equity; and the Court having cognizance thereof, on notice to adverse parties, and other due proceedings had, may adjudge and declare either the patents void in the whole or in part, or inoperative or invalid in any particular part or portion of the United States, according to the interest which the parties to such suit may possess in the patent or the inventions patented, and may also adjudge that such applicant is entitled, according to the principles and provisions of this act, to have and receive a patent for his invention, as specified in his claim, or for any part thereof, as the fact of priority of right or invention shall in any such case be made to appear. And such adjudication, if it be in favor of the right of such applicant, shall authorize the Commissioner to issue such patent on his filing a copy of the adjudication, and otherwise complying with the requisitions of this act. Provided however, That no such judgment or adjudication shall affect the rights of any person except the parties to the action and those deriving title from or under them subsequent to the rendition of such judgment."

[3]Consolidated Patent Act of 1870 (Act of July 8, 1870, ch. 230, 16 Stat. 198):

"Section 52. *And be it further enacted*, That whenever a patent on application is refused, for any reason whatever, either by the commissioner or by the Supreme Court of the District of Columbia upon appeal from the commissioner, the applicant may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof as the facts in the case may appear. And such adjudication if it be in favor of the right of the applicant shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication, and otherwise complying with the requisitions of law. And in all cases where there is no opposing party a copy of the bill shall be served on the commissioner, and all the expenses of the proceeding shall be paid by the applicant, whether the final decision is in his favor or not."

[4]H.R. 1714:

"Section 48. *And be it further enacted*, That whenever a patent or a reissue of a patent is refused on application therefor, after appeal to the Commissioner, for any reason whatsoever, the applicant may give notice to the Commissioner of the points and matters concerning which he deems the decision erroneous, by filing his objections in writing thereto, within thirty days from the rendering of such decision; and he may have his remedy against such erroneous decision by a suit in equity in any circuit court of the United States within whose jurisdiction the Commissioner of Patents and any of the necessary parties to such suit may be found; and all persons who may be interested in such application for a patent

may be made parties to such suit; and the Commissioner and all other persons who may be made parties defendant in such suit, may answer the same and avail themselves of all defenses which the law may allow thereto; *and the subject matter of such suit shall not extend to or include any matter not set forth in the objections to the decision of the Commissioner*, and to the determination upon the evidence of what the invention or discovery of the applicant, and for which he may be entitled to a patent, actually is." (Italics added.)